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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,283	10/20/2003	Thomas E. Valiulis	502454	3164

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EXAMINER

HOGE, GARY CHAPMAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/689,283

Applicant(s)

VALIULIS, THOMAS E.

Examiner

Gary C. Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 12, 13, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka (5,458,307).

Gebka discloses a labeling system 10 for using labels 22 to provide information pertaining to merchandise, comprising a merchandiser adapted to support said merchandise; a label holder 14 mounted to the merchandiser, the label holder including means for supporting one or more labels 22 without an adhesive bond; and a label removably secured to the label holder by the support means, the label including a face stock having printed indicia thereon relating to the merchandise. However, the label disclosed by Gebka doesn't include a friction coating. Instead, the label holder includes a friction coating. It would have been obvious to one having ordinary skill in the art at the time the invention was made to put the friction coating on the label instead of the holder because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 166 (CCPA 1931).

Regarding claim 2, it would have been obvious to make the label of the dimensions recited, because such a modification would have involved a mere change in the size of a

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component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 3, it is not known what material is used to fabricate the label. However, since it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that paper would be suitable for the fabrication of the label, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the label from paper as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claim 5, the recitation that the label includes a bar code and a price does not patentably define over Gebka because it has been held that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. *In re Montgomery*, 102 USPQ 248.

Regarding claims 6 and 7, it is not known what the range of the skid value is. However, it would have been obvious to make the friction coating have the range of skid values recited because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 8, 9, 26 and 27, it is not known what the range of the release value is. However, it would have been obvious to make the friction coating have the range of release values recited because it has been held that where the general conditions of a claim are disclosed

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in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

*In re Aller*, 105 USPQ 233.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka (5,458,307) in view of Wildrick (6,470,613).

Gebka discloses the invention substantially as claimed, as set forth above. However, the label holder is not comprised of two generally co-planar plastic panels. Wildrick teaches that it was known in the art to make a label holder out of two generally co-planar plastic panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the label holder disclosed by Gebka out of two generally co-planar plastic panels, as taught by Wildrick, in order to protect the face of the label from abrasion.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka (5,458,307) in view of Slavsky (2,990,196).

Gebka discloses the invention substantially as claimed, as set forth above. However, the label holder is not curved. Slavsky teaches that it was known in the art to make a curved label holder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the label holder disclosed by Gebka curved, as taught by Slavsky, in order to hold the label in place more securely.

#### ***Response to Arguments***

5. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive.

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Applicant asserts that his invention “is not a mere reversal of the components or parts of Gebka” because Gebka uses a different material than Applicant does, and because Gebka applies that material in a different manner than Applicant does.

According to MPEP § 2144, “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” In this case, the Examiner relied upon legal precedent, specifically *In re Einstein*, 8 USPQ 167. In that case, the Applicant disclosed a moving cam follower and a stationary cam groove. The claims were rejected in view of a reference having a moving cam groove and a stationary cam follower. The court affirmed the Court of Appeals’ conclusion that “a mere reversal of the essential working parts of a previously patented device, did not constitute invention.”

In the instant case, Applicant claims (claim 1) a holder and a label that differs from Gebka’s only in that the friction coating is applied to the label, rather than the holder. This clearly amounts to a mere reversal of the essential working parts of the Gebka device, and, according to MPEP § 2144, “If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.” Thus the Examiner has done. It is further noted that none of the distinctions Applicant relies upon are found in the claim.

Applicant further states that Gebka does not discuss or teach a “weak adhesive.” But Gebka states (column 2, line 36) that the high-friction coating is “tackier” than the material of

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the channel itself. The dictionary defines “tacky” as “slightly adhesive or gummy to the touch; sticky.” In other words, something that is tacky is by definition a weak adhesive.

Finally, Applicant states that “there is no evidence to support the conclusion that a worker in this art would have had a motivation to make the necessary changes in the Gebka reference.” The U.S. Court of Appeals Federal Circuit stated that “the value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts.” *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, the value of legal precedent is that we don’t have to continually “reinvent the wheel,” as it were. We don’t have to decide anew, each time the question comes up, whether it is obvious to reverse the essential working parts of a previously disclosed invention. The court has already held that it is.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

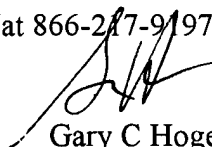
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch